REMARKS/ARGUMENTS

Upon entry of this Amendment and Response Claims 1, 3-5, 7, 8, 13-18, 20-23, 34, and 36-39 will be pending in this application. The present amendment cancels Claims 2, 6, 9-12, 19, 24-33, 35, and 40-49, and amends Claims 1, 3-5, 7, 8, 13-15, 18, 20, 21, 23, 34, and 37. In particular, Claims 1, 34 and 37 are amended *inter alia* to indicate that the resin is an ink-receptive resin. Support for such amendments can be found throughout the specification including on page 6, line 28 to page 7, line 8, where it is indicated that "the regions of the radiation-sensitive layer that remain...are ink-receptive...." Claims 3, 4 and 5 have been amended *inter alia* by removing the reference to a precursor of a radiation sensitive group. Claims 4, and 5 have been amended to specifically show the covalently bonded radiation sensitive moieties rather than merely referring to the precursors of radiation sensitive groups. The point of covalent attachment of these radiation sensitive moieties to the resin is indicated by a squiggly line. Claims 7, 8, 14, 20, 21, and 37 have been amended *inter alia* to correct grammatically awkward sentences. Claim 18 has been amended to correct an obvious error in the chemical structure. Claim 20 has been amended to clarify that the Z moiety is attached to the triazine moiety through the bond indicated by a squiggly line. Other amendments to the claims are generally directed to deleting redundant use of the term "wherein" and other grammatical corrections or changes.

Rejection under 35 U.S.C. § 102

Claims 1-49 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6, 372,403, issued to Kurisaki et al. (hereinafter the "Kurisaki" patent).

Since Claims 3-5, 7, 8, 13-18, 20-23, 36, 38 and 39 are dependent on one of the independent Claims 1, 34 and 37, it is submitted that if these independent claims are patentable, then all dependent claims are also patentable. Therefore, the present response will focus on the patentability of independent Claims 1, 34 and 37.

It is axiomatic that claims are anticipated if, and only if, **each and every element** as set forth in the claim is found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1989). Furthermore, "[t]he **identical inventi n must be shown in as complete detail as is contained in the...claim.**" (emphasis added) *Richardson*

v. Suzuki Motor Co., 9 USPQ2d 1913 (Fed. Cir. 1989). See also, *PPG Industries Inc. v. Guardian Industries Corp.*, 7 USPQ2d 1618, 1624 (Fed. Cir. 1996) ("To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.").

However, as discussed in detail below, it is submitted that the Kurisaki patent does not teach all the elements of the present invention. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §102(e).

Independent Claims 34 and 37

Independent Claims 34 and 37 are directed to an imageable element and a method for producing an imaged element. As amended, both of these claims comprise a substrate comprising a hydrophilic surface and an ink-receptive hydroxyfunctional resin.

In contrast, the Kurisaki patent is directed to a photosensitive resin composition that is useful for forming protective or insulating films, for example, in semiconductor devices, flat panel displays, lithocrystal devices, color filters and thin film transistors. See, for example, column 1, lines 6-12. The Kurisaki patent does not disclose any substrate that comprises a hydrophilic surface. Therefore, the substrate contemplated in the Kurisaki patent is different from that contemplated in the present application. Furthermore, the Kurisaki patent does not disclose that the resin is an ink-receptive resin. **[Paul, I am afraid we may have problem with inherency with this argument.]**

Since not all of the elements claimed in the present invention are disclosed in the Kurisaki patent, Applicants submit that the rejection of Claims 34-39 under 35 U.S.C. §102(e) is improper and should be withdrawn.

Independent Claim 1

As amended, independent Claim 1 is directed, in general, to an imageable composition comprising an ink-receptive hydroxy functional resin. Moreover, unlike the compositions disclosed in the Kurisaki patent, *infra*, compositions of the present invention do not require a polymer having both hydroxyl group and a carboxyl group. Furthermore, while the preamble is generally not considered to be a limitation, "[a]ny terminology in the preamble that

limits the structure of the claimed invention must be treated as a claim limitation." MPEP §2111.02. Thus, as discussed in detail below, the overall composition of the present invention is necessarily different from the compositions disclosed in the Kurisaki patent.

In the present application, the preamble recites an imageable composition which comprises an ink-receptive hydroxyl functional resin covalently bound radiation sensitive group and a cross-linking agent. Imageable compositions are limited to those compositions that can form an image in a lithography process. Since not all polymeric resin compositions are imageable compositions, the preamble clearly limits the scope of the pending claims, i.e., the compositions of the present invention are limited to imageable compositions that are useful in image printing. Imageable compositions are necessarily different from other polymeric compositions that are used for different purposes, such as those discussed in the Kurisaki patent. Furthermore, as amended, the hydroxy functional resin of the present invention must be receptive to ink in order to be useful in image printing processes.

In contrast, the Kurisaki patent discusses photosensitive resins that are used as protective insulating films for semiconductor devices, liquid crystal devices, flat panel displays or the like, as protective films for colored filters, and as protective or insulating films for thin film transistors. There is no disclosure in the Kurisaki patent indicating the insulating polymeric compositions are useful in image printing processes. In fact, imageable compositions and protective insulating films are often used for diametrically opposed purposes. For example, insulating films remain bound to a substrate even when exposed to light thereby protecting the substrate from light, whereas the positive working imageable compositions are designed to be removed by exposure to light and a developing solution to provide an image pattern. Therefore, the overall composition of imageable compositions of the present invention and photosensitive resins discussed in the Kurisaki patent are inherently different.

Therefore, it is submitted that the photosensitive resin compositions discussed in the Kurisaki patent are different from the imageable compositions claimed in the present invention. Since independent Claims 1, 34 and 37 are patentable over the cited art, it is respectfully submitted that the dependent claims are also patentable over the cited reference. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(e).

CONCLUSION

In view of the foregoing, Applicants submit that all claims now pending in this Application are in condition for allowance. Therefore, an early Office Action to that effect is earnestly solicited. If the Examiner believes a telephone conference would aid in the prosecution of this case in any way, please call the undersigned at 303-607-3500.

It is believed that no fees are due with this Amendment and Response. If any such fees are due, however, then please debit such fees to Deposit Account 06-0029.

Respectfully Submitted,

By: _____

Don D. Cha
Registration No. 40,945
Faegre & Benson LLP
3200 Wells Fargo Center
1700 Lincoln Street
Denver, CO 80203-4532

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